

Office Action Summary	Application No. 10/673,239	Applicant(s) MORIOKA ET AL.	
	Examiner Christopher C. Johns	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
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| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>20091209</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Acknowledgements

1. This Office Action is given Paper No. 20091209 for reference purposes only.
2. This Office Action is in response to the Request for Continued Examination, filed by Applicants on 23 November 2009.
3. All references to the capitalized version of “Applicant” refer specifically to the Applicants of record in the instant application. Any references to lowercase versions of “applicant” or “applicants” refer to any or all patent applicants. Unless expressly noted otherwise, references to the capitalized version of “Examiner” refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally. The notations in this paragraph apply to any future Office actions from this Examiner.
4. Claims 15 and 19 are pending.
5. Claims 15 and 19 have been examined.

Continued Examination Under 37 CFR 1.114

6. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 23 November 2009 has been entered.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 15 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over IBM NewGenPay, as disclosed by Electronic Payment Systems for E-Commerce, Second Edition (“IBM”) in view of Official Notice.

9. As per claim 15, IBM discloses:

10. authentication and payment system (figure 7.37) including a terminal apparatus (figure 7.37, “User”), a service providing server (figure 7.37, “Vendor”), an authentication and payment server (figure 7.37, “Payment Provider 1”), and a network connecting the wireless terminal apparatus, service providing server, and authentication and payment server (page 293, “allows a user to make payments to any vendor whose payment provider is connected to the clearing network”);

11. receiving, by a network transceiver of the wireless terminal apparatus from a network transceiver of the authentication and payment server, a certificate of service (figure 7.37, “daily spending certificate”) including a reference amount (page 292, “daily spending certificate, which specifies the maximum amount that can be spent at any one vendor”; known as “spend_limit” in “daily_spend_cert” on page 294);

12. issuing, from the network transceiver unit of the wireless terminal apparatus, a request for use of a service (figure 7.37, “Signed payment order (PO)”; known as “payment” on page 294)

attached with the certificate of service (page 294, “payment = {daily_spend_cert, pay_order}”) to the service processing server;

13. receiving, at the network transceiver of the service providing server, the request for use of a service from the wireless terminal apparatus through the network (figure 7.37, “Signed payment order (PO)”);

14. comparing, at the service providing server, the reference amount in the certificate of service with an amount of payment of the requested service (page 294, last paragraph, “amount”) to determine whether the amount of payment is less than or equal to the reference amount (page 294, ¶5 - “vendor will keep track of how much the user has spent, and provided the spending limit is not exceeded...”);

15. transmitting, from the service providing server to the authentication and payment server, an authentication and payment message (figure 7.37, “Authorization for extra amount”) prior to providing the requested service (page 295, ¶2 - “user attempts a further purchase...vendor...[responds] with a signed authorization to allow further spending”) when the comparing determines that the amount of payment of the requested service is greater than the reference amount (page 295, ¶2 - “If the spending limit is reached at a particular vendor, and the user attempts a further purchase, an on-line authentication is performed with the user’s PP, as shown in figure 7.37”);

16. providing, by the service providing server, the requested service to the wireless terminal apparatus (page 294, ¶5 - “provided the spending limit is not exceeded, purchases will be accepted with off-line verification”; i.e. no verification to a remote server will be made) before the service providing server generates the authentication and payment message that is sent to the

authentication and payment server (page 295, ¶3 - “vendors deposit signed batches of payment orders to their respective PPs at the end of the day”) when the comparing determines that the amount of payment of the requested service is less than or equal to the reference amount (page 294, ¶5 - “provided the spending limit is not exceeded, purchases will be accepted with off-line verification”).

17. IBM does not explicitly disclose:

18. wireless terminal apparatus.

19. The Examiner takes Official Notice that wireless terminal apparatuses was old and well-known in the art because they allow for a more convenient and robust system of transmitting data. By allowing users to use a mobile device, they are not tied to a specific desk or computer and may roam freely - creating a more convenient system. This also enables different paradigms for accessing services; a user would not be able to bring his desktop computer to a merchant's brick-and-mortar store, so by making the system able to be used on a wireless device, the system becomes more widely-usable. This, in turn, would create a more profitable system for its creators, because a system that is more convenient and more widely-usable is a system that users would be more likely to purchase and use.

20. Therefore, it would have been obvious to a person having ordinary skill in the art to include in IBM the concept of a wireless terminal apparatus, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would

have recognized that the results of the combination were predictable, as well as advantageous because it would create a more convenient, widely-usable, and profitable system.

21. Claim 19 is rejected under similar reasoning due to its similarity to claim 15.

Response to Arguments

22. Applicants' arguments with respect to the claims have been considered but are moot in view of the new ground of rejection. They argue limitations that were not previously in the claims – as they have been fully addressed in this Office Action, the arguments are overcome.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a. Micro-Payments based on iKP. Hauser, Ralf et al. Published 16 January 1996.

See especially §4.3; and

b. A Set of Protocols for Micropayments in Distributed Systems. Tang, Lei.

Published in the Proceedings of the First USENIX Workshop on Electronic Commerce.

USENIX, New York, 1995. See especially §5.

24. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

25. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Johns/
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621